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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/540,632

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7609 7590 09/17/2008  
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EXAMINER

SULLIVAN, DANIELLE D

ART UNIT

PAPER NUMBER

1616

MAIL DATE

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09/17/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/540,632	<b>Applicant(s)</b> SUDA ET AL.	
	<b>Examiner</b> DANIELLE SULLIVAN	<b>Art Unit</b> 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of Claims***

Claims 1 and 3-12 are pending. Claim 2 was cancelled in the amendment filed 5/28/2008.

### ***Specification***

Applicants Amendments to the Specification were filed on 5/28/2008.

The disclosure is objected to because of the following informalities: [0061] needs to be rewritten with proper justification so words are not abruptly disjointed.

Appropriate correction is required.

Applicant has failed to resolve issues present in the specification. Applicant has removed a period, due to improper punctuation and fixed plural terms, however, the writing is still disjointed because the listing of ingredients is written with poor grammar. For example, "; and so on can be listed". What is meant by this?

SUGGESTION: In reference to Applicant's amendment's to correct the rejections of claims 10 and 11 under USC 101, applicant's amended the use to a method of use. The applicant should claim a method of applying the composition if this is the process being claimed.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The following rejection was necessitated by applicant's amendments.

Claim 1 recites the limitation "wherein the covering rate of zinc oxide is..." in reference to the fact that the lipophilic base is covered with zinc oxide. There is insufficient antecedent basis for this limitation in the claim.

***Withdrawn rejections***

Applicant's amendments and arguments filed 05/28/2008 are acknowledged and have been fully considered. Any rejection and/or objection not specifically addressed below are herein withdrawn.

***Response to Arguments***

Applicant has amended claim 1 to overcome the rejections under 112, second paragraph and 102(b) as being anticipated by Nakane et al. Applicant's amendments filed 5/28/2008 have amended claim 1 to read on a composition comprising a complex powder including lipophilic base powder and zinc oxide, where the surface of lipophilic base powder is covered with zinc oxide and wherein the covering rate of zinc oxide is in the range of 1-90% relative to the total surface area of said lipophilic base powder.

Applicant's arguments with respect to claim 1 and 3-12 have been considered but are moot in view of the new ground(s) of rejection.

The following rejection is necessitated by applicant's amendments.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 3-12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-30 of copending Application No. US 2004/0175386 in view of Nakane et al. (US 5,122,418). Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application comprises the complex powder. Copending application '386 does not teach the complex powder is dispersed in an oil phase. It is for this reason that Nakane et al. is joined.

Nakane et al. teaches a composition for protecting skin from the sun comprising; a complex powder including lipophilic base powder and zinc oxide, where the surface of lipophilic base powder is covered with zinc oxide; and an oil component (Example 25). The composition contains 30% zinc oxide covered polymethyl metacrylate (7%) in the form of an emulsion in silicone oil (dimethylpolysiloxane 10%). The lipophilic base powder is dispersed in the oil component (column 26, lines 12-21).

Therefore, it would have been obvious to one of ordinary skill in the art to combine the teachings of '386 and Nakane et al. to utilize the complex powder as an emulsion in silicone oil. One would have been motivated to use the complex powder is dispersed in an oil phase because Nakane teaches that the emulsion obtained is effective as a sunscreen.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakane et al. (US 5,122,418).

Applicants claim a complex powder comprising a lipophilic base powder and zinc oxide, where the surface of lipophilic base powder is covered with zinc oxide, the zeta-potential of said lipophilic base powder is a negative value at pH 7.5 and the covering rate of zinc oxide is in the range of 1-90% relative to the total surface area of said lipophilic base powder when said lipophilic base is dispersed in said oil.

Nakane teaches a composition for protecting skin from the sun comprising; a complex powder including lipophilic base powder and zinc oxide, where the surface of lipophilic base powder is covered with zinc oxide; and an oil component (Example 25). The composition contains 30% zinc oxide covered polymethyl metacrylate (7%) in the form of an emulsion in silicone oil (dimethylpolysiloxane 10%). The lipophilic base powder is dispersed in the oil component (column 26, lines 12-21).

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Danielle Sullivan whose telephone number is (571) 270-3285. The examiner can normally be reached on 7:30 AM - 5:00 PM Mon-Thur EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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